UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,116	10/22/2001	David Sauer	IP1-0106	5698

32968 7590 08/12/2005

KYOCERA WIRELESS CORP.
P.O. BOX 928289
SAN DIEGO, CA 92192-8289

EXAMINER	
GENACK, MATTHEW W	
ART UNIT	**PAPER NUMBER**
2645	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,116	SAUER ET AL.	
	Examiner	Art Unit	
	Matthew W. Genack	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *21 March 2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-8, 11-12, 16-18, 21-22, 25-26, 30, 33-36, 39-40, 44-46, 49-50, and 53-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilk, U.S. Patent No. 6,768,789.

Regarding Claims 1 and 30, Wilk discloses a method and device for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17). Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35, Fig. 1). Said wireless telephone memory stores a plurality of predefined outgoing messages (Column 3 Lines 36-41, Column 4 Lines 10-30). The predefined messages may be provided in a plurality of languages (Column 7 Lines 24-30). The callee selects an outgoing message and plays selected message for the caller (Column 5 Lines 49-62, Fig. 2).

Regarding Claims 4 and 33, Wilk discloses a method and device for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17). Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35,

Fig. 1). Said wireless telephone memory stores customizable concatenated outgoing messages, said messages having customizable portions that may be entered as text with the use of the wireless telephone's keypad (Column 4 Line 10 to Column 5 Line 4). The callee selects an outgoing message and plays selected message for the caller (Column 5 Lines 49-62, Fig. 2).

Regarding Claims 6 and 35, Wilk discloses a method and device for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17). Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35, Fig. 1). Said wireless telephone memory stores customizable outgoing messages, said messages having customizable portions that may be entered as text with the use of the wireless telephone's keypad, as well as predefined portions (Column 4 Line 10 to Column 5 Line 4). The callee selects an outgoing message and plays selected message for the caller (Column 5 Lines 49-62, Fig. 2).

Claims 16 and 44 differ substantively from Claim 1 in that Claims 16 and 44 recite a plurality of mobiles being involved in the communication. Wilk discloses two-way communication between the caller and the callee (Fig. 1). The caller may be using any type of wireless telephone that allows a connection to be made over the PSTN (Column 3 Line 56 to Column 4 Line 4).

Regarding Claims 5, 7, 34, and 36, Wilk discloses that the callee may enter text information, via the wireless telephone's keypad, into the customizable text entry portion of the stored predefined messages (Column 4 Lines 41-53). The callee may specify the entry of default terms such as "buy" and "sell" into the customizable text entry portion for

certain types of stored predefined messages (Column 4 Line 65 to Column 5 Line 4). The callee may enter defined information into the customizable text entry portion of the stored predefined message (Column 4 Lines 58-64).

Regarding Claim 8, the information inputted by the user, with the wireless telephone's keypad, comprises characters (Column 5 Line 63 to Column 6 Line 4).

Regarding Claims 11-12, 22, 25, 39-40, and 50, Wilk discloses that the outgoing messages may be provided in a plurality of languages (Column 7 Lines 24-30).

Regarding Claims 17-18, 26, 45-46, and 53-54, Wilk discloses that the wireless telephone communicates with the base station via a wireless link that may be based on CDMA (Code Division Multiple Access) (Column 3 Lines 2-5, Fig. 1). Since CDMA is a digital standard, information that is transmitted from a CDMA telephone is in a digital format. Voice and text that are inputted into such a wireless telephone are therefore encoded upon storage, and when transmitted, are also transmitted by code.

The rejections of Claims 21 and 49 are parallel to that of Claim 6.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 15, 29, 43, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Enns *et. al.*, U.S. Patent Application Publication 2002/0116499.

Regarding Claims 15 and 43, Wilk discloses the recording and storing of outgoing audio messages in the wireless telephone's memory (Column 2 Lines 29-49, Column 5 Lines 49-62, Fig. 2).

Wilk does not expressly disclose the storage of a defined contacts list of message recipients in the wireless telephone's memory.

Enns *et. al.* discloses a method and device for sending a message from a mobile device to specified recipients, said recipients being in a list stored in said mobile device (Abstract, [0004], [0017], [0019], [0059], Figs. 1 and 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by including a list of contacts in the wireless telephone and enabling the transmission of a message to one or more of these contacts.

One of ordinary skill in the art would have been motivated to make this modification because contact lists allow quick and easy communication with one or more individuals.

Regarding Claims 29 and 57, Wilk discloses a method, system, and apparatus for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17). Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35, Fig. 1). Said wireless telephone memory stores a plurality of predefined and customizable outgoing messages (Column 3 Lines 36-41, Column 4 Line 10 to Column 5 Line 4). Wilk discloses that the outgoing messages may be provided in a plurality of languages (Column 7 Lines 24-30). Wilk discloses that the wireless

telephone communicates with the base station via a wireless link that may be based on CDMA (Code Division Multiple Access) (Column 3 Lines 2-5, Fig. 1). Since CDMA is a digital standard, information that is transmitted from a CDMA telephone is in a digital format. Voice and text that are inputted into such a wireless telephone are therefore encoded upon storage, and when transmitted, are also transmitted by code.

Wilk does not expressly disclose the transmission of messages to servers and computers.

Enns *et. al.* discloses a method and system for sending a message from a mobile device (Abstract, [0004], Fig. 1). The mobile device may communicate with both a computer and a gateway ([0016], Fig. 1).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by providing for the ability to allow send messages from the wireless telephone and computers and servers.

One of ordinary skill in the art would have been motivated to make this modification because the need for communication between wireless devices and computers and servers is growing.

Regarding Claims 2-3, 13-14, 19-20, 27-28, 31-32, 41-42, 47-48, and 55-56, Wilk discloses that outgoing messages may be provided in a plurality of languages (Column 7 Lines 24-30). Therefore, by selecting a particular message, a transmission language is selected. The wireless telephone memory stores a plurality of predefined and customizable outgoing messages (Column 3 Lines 36-41, Column 4 Line 10 to Column 5 Line 4).

Wilk does not expressly disclose the storage of a defined contacts list of message recipients in the wireless telephone's memory.

Enns *et. al.* discloses a method and system for sending a message from a mobile device to one or several specified recipient(s), said recipient(s) being in a list stored in said mobile device (Abstract, [0004], [0017], [0019], [0059], Figs. 1 and 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by including a list of contacts in the wireless telephone and enabling the transmission of a message or messages (of one or more languages) to one contact, or to several respective contacts, wherein a given contact receives one of the plurality of transmitted messages in the appropriate language.

One of ordinary skill in the art would have been motivated to make this modification because contact lists allow quick and easy communication with one or more individuals, and the use of a contact list in this manner would allow a message to be sent to users in a plurality of languages.

Regarding Claims 10, 23, 38, and 51, Wilk discloses the use of predefined text for use with customizable messages (Column 4 Line 54 to Column 5 Line 4).

Wilk does not expressly disclose the use of recipient contact information with customizable messages.

Enns *et. al.* discloses a method and system for sending a message from a mobile device to specified recipients, said recipients being in a list stored in said mobile device (Abstract, [0004], [0017], [0019], [0059], Figs. 1 and 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by providing for the use of recipient contact information in customizable messages.

One of ordinary skill in the art would have been motivated to make this modification so as to allow the quick entry of information, pertaining to a third party, into a customizable message (located on the contact list) during communication with another individual.

Regarding Claims 24 and 52, Wilk discloses that the outgoing messages may be provided in a plurality of languages (Column 7 Lines 24-30).

5. Claims 9 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Makela *et. al.*, U.S. Patent Application Publication 2001/0028709.

Wilk does not expressly disclose the inclusion of calendar and clock information in outgoing messages.

Makela *et. al.* discloses a mobile communication device, capable of SMS, that includes time information in messages (Abstract, [0022], Fig. 1). Said time information comes from a clock or calendar program ([0027]).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by providing for the inclusion of either clock information or calendar information as the default information of certain customizable messages.

One of ordinary skill in the art would have been motivated to make this modification so that the recipients would know the time at which the sender sent the customizable message.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 571-272-7541. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Matthew Genack

Examiner

Art Unit 2645

Matthew Genack

3 August 2005